

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFERY M. ENRIGHT, KEVIN F. MARTIN,
BRAD STEPHENSON, ROY HATHAWAY,
TOM KEHNER, CHRISTOPHER J. KNOUFF,
KENNETH C. VARN, JEFFREY R. THOMAS,
JAY PAUL DRUMMOND, JOHN KORTIS,
DAVID A. CRANE, EVAN F. GOLDRING,
ROBERT NOVITSKEY, MICHAEL RUSSELL,
MICHAEL MOTT, CHRIS DIVITA,
AND DOUG WILLIAMS

Appeal 2007-0069
Application 10/603,266¹
Technology Center 2600

Decided: May 3, 2007

Before KENNETH W. HAIRSTON, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

¹ Application filed June 23, 2003. Appellant claims the benefit under 35 U.S.C. § 119 of provisional application 60/103731, filed 10/09/1998. Application 10/603,266 is a divisional of 09/414,249, filed 10/07/1999. The real party in interest is Diebold, Incorporated, an Ohio corporation.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 and 68 to 89 under authority of 35 U.S.C. § 134 (2002). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants' invention relates to a method and apparatus for taking an image of a check in an ATM type of machine, and producing a markup language document corresponding to indicia on the check.

Claims 1 and 87 are exemplary:

1. A method comprising the steps of:

- (a) receiving a check into an automated banking machine, the automated banking machine including a cash dispenser;
- (b) capturing an image including indicia on the check through operation of an imaging device in the machine;
- (c) operating at least one computer in operative connection with the imaging device to produce at least one markup language document corresponding to indicia on the check.

87. Apparatus comprising:

a check analysis terminal,

wherein the terminal includes at least one computer,

wherein the terminal includes at least one input device,

wherein the terminal includes at least one display device,
at least one data store,

wherein the at least one data store includes check transaction data corresponding to at least one image captured of at least a portion of a check during a check receiving transaction at a cash dispensing automated banking machine,

wherein the at least one data store is in operative connection with the at least one computer,

wherein the at least one computer is operative to receive additional check transaction data in at least one markup language document,

wherein the at least one computer is operative to cause received check transaction data to be stored in the at least one data store, and

wherein the at least one computer is operative responsive to at least one input to the at least one input device to cause a visual representation corresponding to stored check transaction data to be output through the at least one display device.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Cook	5,860,068	Jan. 12, 1999
Gustin	5,897,625	Apr. 27, 1999
Anderson	6,209,095	Mar. 27, 2001

Group I: The Examiner rejected claims 1, 68 to 70 and 72 to 89 under 35 U.S.C. § 103(a) as being obvious over Gustin in view of Anderson.

Group II : The Examiner rejected claim 71 under 35 U.S.C. 103(a) as being obvious over Gustin in view of Anderson. This rejection originally also relied up the Cook reference, but that reference was later considered cumulative. (Answer 22). With that understanding, the rejections will be considered as a whole, on all remaining claims 1 and 68 to 89.

Appellants contend that the claimed subject matter is not rendered obvious by Gustin alone, or in combination with Anderson, for reasons to be discussed more fully below. The Examiner contends that each group of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting claims 1, and 68 to 89 under 35 U.S.C. § 103(a). The issue turns on whether there is a legally sufficient justification for combining the disclosures of Gustin and Anderson to meet the claimed limitations. More specifically, the issue is whether the teachings of markup language documents in Anderson can be combined with the ATM and image scanning teachings of Gustin to render the claims obvious under 35 U.S.C. § 103(a).

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

Findings with respect to the rejection of claims 1, and 68 to 89 under 35 U.S.C. § 103(a) for being obvious over Gustin in view of Anderson.

1. Appellants have invented an improved ATM type automated banking machine where a deposited check is imaged through the operation of an imaging device in the machine. (Claim 1, Specification 41) This aspect of the invention was demonstrated by the Examiner to be part of the prior art, namely in the reference patent to Gustin (col. 13, top) and in the reference patent to Anderson (col. 7, ll. 41-50).
2. In addition to the image data of the scanned checks, the Appellants capture transaction data or other data using other components of the machine and correlate that other data with the image data representative of the scanned checks. (Specification, 58, ll. 10 ff). That data, which can be representative of indicia on the check, can be used to verify the genuineness of the checks. For example, signatures can be checked by this technique (58, bottom), checking the images against stored signature data (59, ll. 10-17). Other examples of the type of information that may be used for verification are presented in the Specification, such as on page 60, lines 10 to 20.
3. This information, transaction and image documents, may travel on networks (Appellants' Fig. 13, #234), including the Internet,

using standard protocols, such as TCP/intellectual property (Specification 24). Records can be in HTML, XML and other markup languages. (Specification 24, ll. 5-7 for the protocols). The nature of these documents is variously described. They may be images of the handwriting and signatures on checks (41, ll. 11-18) or other image data to be compared by eye or by machine (59, ll. 5-17). The data can also include transaction data related to the bill dispenser of the ATM, to the printing devices for printing transaction receipts and records, and instructions to control, coordinate and limit the operation of the transaction function devices within the ATM. (Specification 50 and 51, top). All of these references in the Specification were presented by the Appellants in relating independent claim 1 to the supporting disclosures in the Specification. (Br. 6). They are recited here to further an understanding of the scope of the claimed limitations.

4. In claim 1, and claims 86 to 89, the Briefs and Answer have focused on the meaning of the third limitation of claim 1, namely "...operating at least one computer in operative connection with the imaging device to produce at least one markup language document corresponding to indicia on the check." When this language is interpreted in view of the Specification, it becomes clear that the stated markup language document corresponding to indicia on the check need not be limited to only where a reference "converts an imaged paper

check to a markup language document”. (See Reply Br. 11 in which this was a major point of the Appellants.) The markup language document as claimed need only contain information corresponding to the information on the check. In the instant invention, as the terms are used in the Specification, this claimed “corresponding information” transferred according to standard Internet protocols can be image data and transaction data, suitably “wrapped” in HTTP and TCP/IP- tags. (See the citations in paragraph 3 above.)

5. In the Examiner’s Answer, pages 3 and 4, Examiner relates how Anderson discloses an electronic check system. In the teachings of Anderson, he “discloses that it is known to use a markup language to identify and generate financial markup language documents in order to provide a tagged structure of checks in order to implement a conventional well known web browser procedure for verification purposes in electronic transactions across the Internet.” (references omitted). In Anderson at columns 18, 19 and 28 are disclosures using markup languages to display transaction data, and images, as claimed and as disclosed by Appellants. As the reference Gustin teaches using TIFF images of checks and verifying signature and transaction data over networks (col. 13), and as Anderson addresses the same field of endeavor with the added teaching of the Internet and markup language protocols for the same image and transactional data, we find the rejection based

on the two references to be appropriate for rendering the claims obvious.

6. Claim 68: As the Examiner in his Answer points out, in Gustin the system and method receive inputs from the users of the ATM from whom a check is received (Gustin, col. 8) correlated to the nature of the check (e.g. the amount entered in a keypad). This is part of the transaction data for the markup language documents (Gustin, col. 12; Anderson, col. 30).
7. Claim 69-71: Gustin, in column 9 top, discloses the storing of transaction data. As described above, the encoding into markup language of that same data is taught by Anderson in column 19.
8. Claim 72: As described above, authenticating information can be merely the image of the check, or the signature on the check. Anderson teaches such information to be in markup language.
9. Claim 74, 75, 76, 77, 78, 79, and 80: As noted by the Examiner, Gustin in column 13, lines 25-45 *ff* meets the claimed limitations, including signature analysis at a remote location. Transfer by Anderson's Internet protocols discloses a browser interface. See column 16, line 10 *ff*. Note servers both in Gustin and Anderson, as described by the Examiner.
10. Claims 81-85: As stated in the rejection, we find Gustin in column 12, lines 55 *ff* teach scanning the terminal data for selected parameters, such as checking account numbers. Output

devices are described at remote locations in Gustin, column 13 and in Anderson.

PRINCIPLES OF LAW

On appeal, Appellants bears the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states, “[t]he terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003).

References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796

F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004).

ANALYSIS

Appellant has contended that the Examiner erred in rejecting claims 1 and 68 to 89 under 35 U.S.C. § 103(a). Reviewing the findings of facts cited above, we find that the Examiner has correctly combined the teachings of two references in the same field of endeavor to render the claims obvious over the prior art. Gustin discloses an ATM machine with scanned images of submitted checks and other standard ATM features, plus connections to remote terminals for transferring the image data and transaction data. Anderson teaches using the Internet for similar communications, with the concomitant use of Internet protocols including documents in markup languages.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 and 68 to 89. The rejection of those claims is affirmed.

OTHER ISSUES

Examiner and Appellants are reminded that even when frustration over the examination process is high, decorum is expected and required by regulations and the standards of our profession.

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DECISION

The Examiner's rejection of claims 1 and 68 to 89 is Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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